REMARKS

The Office Action dated December 29, 2005 has been carefully reviewed and this response is submitted in response thereto. Independent claims 1 and 5 have been amended. Claims 1-8 remain pending. No new matter has been added by this amendment and support may be found in paragraph [0011] and Figure 1 of the specification.

35 U.S.C. §103

Claim rejections using Sakurai et al. in view of Paoluccio

Claims 1-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,790,287 to *Sakurai et al.* in view of U.S. Patent No. 4,616,620 to *Paoluccio.* Applicants respectfully traverse the rejections.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03.

Amended independent claims 1 and 5 recite an oil separator for an internal combustion engine comprising, among other limitations, "a valve cover, said valve cover having a recess with at least one drain hole formed therein; a basket at least partially disposed in said recess ...." This limitation is not taught or suggested by the prior art of record.

Sakurai et al. teaches a separator (55) that is contained within a crankcase chamber of a cylinder block. The examiner acknowledges that the Sakurai et al. does not teach a basket located in a valve cover as positively claimed by the Applicants.

However, *Paoluccio* does nothing to cure the deficiencies of *Sakurai et al.* Indeed, *Paoluccio* teaches a contamination control apparatus configured to prevent ambient air and moisture from entering an engine crankcase. The apparatus includes, among other things, a desiccant dryer that constantly removes any moisture from the air within the interior of the engine and oil distribution system whenever the engine is off. The apparatus is installed directly on a portion of the engine that becomes hot when the engine is running, such as the exhaust manifold. (See Column 3, lns. 45-48) Amended independent claims 1 and 5 explicitly recite an oil separator comprising, among other things, "a valve cover, ...having a recess ...formed therein; a basket at least partially disposed in said recess...". Contrary to the Examiner's

4

Application No. 10/707,182

Docket No.: 60680-1722

assertion, neither *Sakurai et al.* nor *Paoluccio*, either standing alone or in combination, teach or suggest these limitations. Accordingly, independent claims 1 and 5, as well as their respective dependent claims, are patentable.

CONCLUSION

In view of the above remarks and arguments, Applicants believe the pending application is in condition for allowance. Favorable reconsideration and early allowance are earnestly solicited.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1722 from which the undersigned is authorized to draw.

Dated: <u>February 28, 2006</u>

Respectfully submitted,

By

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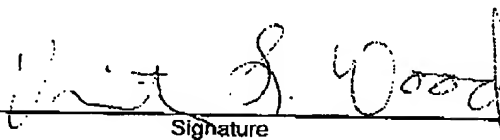
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Application No. (if known): 10/707,182   Attorney Docket No.: 60680-1722

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Amendment (5 pages)

2